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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,947	03/08/2004	James A. Bolton	Grafted 1.3	1422

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/795,947

Applicant(s)

BOLTON ET AL.

Examiner

Frederick J. Parker

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 5-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-4,13-16 in the reply filed on 10-19-06 is acknowledged. The traversal is on the ground(s) that (1) Applicants argue the 3 inventions are linked by "their very terms", (2) there is "simply no way" to "thoroughly" search the method without searching kit art (3) the specification cites a method and kit to solve a "real prior art problem" (4) the claims include "a community of properties...not repugnant" to classification and continues on to describe the invention (5) asserts restriction puts form over substance utilizing an "arcane classification procedure" for filing paper patents into shoes, and (6) the need for Applicants to pay multiple fees for multiple inventions causes undue burden on Applicants. It is noted Applicants appear to not argue relative to Group III. Arguments are not found persuasive because (1) linkage regarding verbiage fails to prove the inventions are not separate and distinct; the Examiner properly proved in the past Office Action, and Applicants failed to overcome, the reasons as to why the Groups are separate and distinct in accordance with USPTO practice. (2) Applicants' inference connected with telling the Primary Examiner where to search is not persuasive, given his extensive experience in searching. (3) the content of the Specification relative to restriction beyond reading claims in light of the specification is irrelevant, as is its purported solution of a "real prior art problem". (4) the Examiner does not understand the relevance of this argument to Restriction issues. (5) this argument respectfully lacks understanding of the Classification system and the effects of classification on searching. Classification was used to classify paper patents, but the Office also recognizes it is indispensable to allow assignment of an application to the proper Examiner, which permits a

Art Unit: 1762

complete, thorough, and expert search by an Examiner knowledgeable in a specific art area who knows where to search and not to search for a given invention. Classification is “hardly “arcane” and computerization has simply proved the value of classification because text searching alone fails to identify the best prior art. (6) The Examiner is sympathetic to this argument, but the fees and practices of the USPTO are available to the public, and the Examiner has no influence over the rules and practices other than the requirement to abide by, and enforce, PTO rules and practices.

The Examiner adds Applicants fail to recognize that issues of examination and considerations of patentability arising from the examination of additional unfamiliar and diverse art areas by examining additional and unrelated inventions, beyond the additional search, would pose an undue burden on the Examiner and potentially compromise the quality of the end product.

The requirement is still deemed proper and is therefore made FINAL.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title is too generic and does not reflect the invention.

Claim Objections

3. Claim 1 is objected to because of the following informalities: (1) claim 1, line 3, it is suggested that “a” be inserted before “base coat” for proper sentence flow. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 13 & 16 are vague and indefinite because (1) it is unclear what is meant by “faithfully reproduces”, and what criteria determine whether or not a finish is *faithfully* reproduced, (2) it is unclear how a “brilliant finish” can be characterized by UV stability and chemical resistance, and (3) it is unclear to what chemicals/ chemical reactions the finish is resistant.
- Claim 14 is vague and indefinite because the coating compositions of (1) and (3) as set forth are identical, so it is unclear if or how the compositions are intended to vary to carry out the method.
- Claims 15-16 are vague and indefinite because it is unclear WHICH acrylic in claim 14 is intended in each dependant claim since claim 14 lists an acrylic in both steps (1) AND (3).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1762

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by Pittman et al US 5534352.

Pittman teaches composite panels with embossed textured surfaces to which is applied a uniform pigmented aqueous base/ground coating; followed by drying; followed by spraying an aqueous pigmented “buffing coat” (same as “graining coat” since it provides similar/ same end-function) which is then dried; and buffing the surface to redistribute the coat from flat or profiled areas while leaving the coat IN the textured recesses. Column 3, 20 col. 4, 62. The product is a natural appearing wood-grain finish on the textured surface. The base/ background coating is stated to be an aqueous acrylic emulsion with pigments (by definition, a “paint”), the resin component being substantially hard to impart “slickness” (col. 3, 40-53). The reference therefore anticipates the limitations of the claim as written.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1762

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pittman et al.

Pittman is cited for the same reasons previously discussed, which are incorporated herein. Rate of spraying and specific acrylic coatings are not cited. The rate of spraying per unit area is simply a matter of a desired coloration/ graining of an end-product, which would have been optimized by one of ordinary skill using routine experimentation, absent a clear and convincing showing of unexpected results/ evidence to the contrary. Process conditions do not patentably distinguish over prior art where they are merely modifications of an old process capable of being made by one of ordinary skill, In re Budde 138 USPQ 71+. Further, Pittman is not limited to specific acrylic emulsions and would include those capable of being cross-linkable, per claim 3. The Examiner notes the invention never requires a positive step of cross-linking the acrylic base/ ground coat. It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Pittman and optimizing spraying rate by routine experimentation to provide a desired coloration for a specific graining coloration of the textured surface using any useful acrylic resin phase because spray rate is a convention operating parameter known to the skilled practioner and acrylics without limitation are cited by Pittman.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pittman et al in view of Porter US 6201057.

Art Unit: 1762

Pittman is cited for the same reasons previously discussed, which are incorporated herein. A urethane/acrylic hybrid grain coat is not cited.

Porter teaches an aqueous acrylic-(poly)urethane coating material applied to a pigmented basecoat on a surface requiring weathering resistance, e.g. doors and entry components. The coating material may be clear or modified with materials conventionally known as pigments, e.g. titania. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Pittman by substituting the buffing coat with the acrylic/(poly)urethane coating of Porter to provide the benefit of weathering resistance to the grained, textured surface.

Claim Rejections - 35 USC § 103

12. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pittman in view of Vasisht et al US 4432797.

Pittman et al is cited for the same reasons previously discussed, which are incorporated herein.

Vasisht et al teaches a similar aqueous stain basecoat including pigmented acrylic emulsions (col. 3, 8-15 Ex. 4b) which are applied to surfaces and dried to form a desired simulated wood appearance, the specific simulated wood being the choice of pigment/s selected by the skilled practitioner (see col. 2, 5-8). The reference further teaches the importance of using surfactants to lower surface tensions and thereby helps to wet pigments, resulting in better color development of stained surfaces after drying (col. 6, 46-60 and EX. 4a). The reference teaches improved coloration and hence “faithfully reproduces” the intended coloration. Thus the use of coatings with different pigments to provide specific colorations or simulated wood effects would have

Art Unit: 1762

been obvious to one of ordinary skill, whether for the base coat or any subsequent coats as per claim 14, the result being merely a desired aesthetic effect. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, In re Seid 73 USPQ 431. The recitation teaches those formulations without surfactant develop a “whitish haze” and hence those with the additions have a more brilliant finish. The presence of the stain coatings necessarily provides ultraviolet stability and chemical resistance relative to surfaces without the coatings, and particularly given the similar formulations of the prior art and claim 13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Pittman et al and incorporating in the pigmented formulation/s a surfactant as taught by Vasishth et al to provide the express motivation of wetting the pigments to result in better color development of stained surfaces after drying.

13. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pittman et al in view of Vasishth et al and further in view of Porter US 6201057.

Pittman and Vasishth et al are cited for the same reasons previously discussed, which are incorporated herein. A urethane/acrylic hybrid grain coat is not cited.

Porter teaches an aqueous acrylic-(poly)urethane coating material applied to a pigmented basecoat on a surface requiring weathering resistance, e.g. doors and entry components. The coating material may be clear or modified with materials conventionally known as pigments, e.g. titania. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Pittman in view of Vasishth et al by substituting the buffing

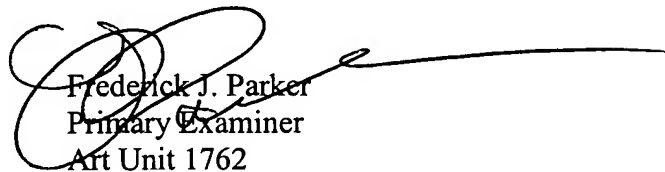
Art Unit: 1762

coat with the acrylic/(poly)urethane coating of Porter to provide the benefit of weathering resistance to the grained, textured surface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp
